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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,463	09/20/2000	Aude Livoreil	05725.0758-00000	7146
22852	7590	11/03/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/666,463

Applicant(s)

LIVOREIL, AUDE

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1,2,4,6-11,13-17,19,21-26,28-55,59,66,68-74 and 77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,2,4,6-11,14-17,19,21-26,29-55,59,66 and 68-73 is/are allowed.
- 6) ☐ Claim(s) 13,28,74,77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1616

### **DETAILED ACTION**

Applicant's arguments, see paper, filed 8/5/05, with respect to the rejection(s) of claim(s) under 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraphs have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of rejections set forth below.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13,28 recite the limitation "cis-1,3,5-tris(palmitoylaminocarbonyl)cyclohexane" and cis-1,3,5-tris(lauroylaminocarbonyl)cyclohexane" in lines 3,4 and 4,5 respectively. There is insufficient antecedent basis for this limitation in the claim. According to independent claims 1 and 14, R' is required to have a C=C double bond. The two named cyclohexanes above lack C=C double bond.

#### ***Double Patenting Rejection***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1616

Claims 74 and 75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,6-8,35-37,42 of U.S. Patent No. 6372235. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application and patent make claim to similar inventions. Note that instant application's claims 74 and 77 are to a compound and composition comprising a cyclohexane moiety having at least one R' as an aryl and the other R' groups as linear, branched and cyclic, saturated and unsaturated hydrocarbons comprising 1 to 22 carbon atoms or hydrogen. Note that USPN '235 discloses a cyclohexane moiety having R' selected from a group comprising aryl as well as linear, branched and cyclic, saturated and unsaturated hydrocarbons comprising 1 to 22 carbon atoms. Instant invention differs from USPN '235 in that instant invention requires that at least one R' is an aryl; whereas, USPN '235 recites aryl as a selection in R' Markush group. The other selections in R' of USPN '235 are hydrogen, aralkyl, and linear, branched and cyclic, saturated and unsaturated hydrocarbons comprising 1 to 22 carbon atoms. For this reason, it would have been obvious to one having ordinary skill in the art to make the instant invention having at least one R' being aryl since USPN '235 teaches R' being aryl the Markush group. USPN '235 also differs from instant invention in that USPN '235 claims the composition containing the cyclohexane as having less than 0.5% wax. USPN '235 even discloses that the wax content is zero. Therefore, it is obvious that the patented invention can lack oil making the patented claims reading obviously as the instant composition claim 77. Also, note that when no oil is present, USPN '235 claims read obviously as instant claim 74 which is to the

Art Unit: 1616

compounds. Both inventions are to the use of the composition / compound as a cosmetic to be applied to the body.

***Allowable Subject Matter***

Claims 1,2,4,6-11,14-17,19,21-26,29-55,59,66 and 68-73 are allowable the prior art does not teach or disclose the instant invention, wherein at least one R' is chosen from a linear and branched, unsaturated hydrocarbon comprising 2 to 22 carbon atoms and one C=C double bond.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

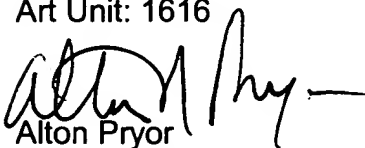
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/666,463

Page 5

Art Unit: 1616

A handwritten signature in black ink, appearing to read "Alton Pryor", with a horizontal line extending from the end of the signature.

Alton Pryor  
Primary Examiner

AU 1616